

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Roy Ben-Yoseph                      Art Unit : 2146  
Serial No. : 10/747,676                      Examiner : Shaq Taha  
Filed : December 30, 2003                      Conf. No. : 2911  
Title : IDENTIFYING AND USING IDENTITIES DEEMED TO BE KNOWN TO A  
USER

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

BRIEF ON APPEAL

Appellants hereby submit this Brief on Appeal in response to the final Office Action dated March 31, 2008 and further to the Notice of Appeal filed September 2, 2008.

**(1) Real Party in Interest**

AOL, LLC, the assignee of this application, is the real party in interest.

**(2) Related Appeals and Interferences**

There are no related appeals and interferences.

**(3) Status of Claims**

Claims 1-55 are pending in the application, with claims 1, 28, and 55 being independent.

**(4) Status of Amendments**

The amendments to claims 1, 10-13, 28, 37-40 and 55 filed on June 2, 2008 were not entered. Since these amendments simply addressed antecedent issues and do not affect the issues on appeal, the Applicant has not sought further entry of these amendments.

**(5) Summary of Claimed Subject Matter**

Independent claim 1 is directed to a method of maintaining a list of people known to a user and using the list to control communications between the user and others. See, e.g., Application at page 1 line 7 to page 10 line 2. As recited in claim 1, a list of people known to a

user is maintained. See, e.g., Application at page 6 line 7 to page 10 line 2, and FIG. 2. A message directed from a sender to the user is received and the user is enabled to interact with the message from the sender. . See, e.g., Application at page 13 line 26 to page 17 line 14; and FIG. 6-7. The person is determined to be associated with the user based, at least in part, on interactions between the user and the received message directed to the user. The sender is added to the list when the person is determined to be known to the user based, at least in part, on interactions between the user and the received message; See, e.g., Application at page 14 line 22 to page 15 line 6; page 19 line 3 to page 20 line 13; and FIG. 8-9. The list is used to control aspects of communications between the user and others based on whether the others are included on the list. See, e.g., Application at page 20 line 14 to page 24 line 11; FIG. 10-12; page 26 line 19 to page 27 line 9 and FIG. 16.

Independent claim 28 is directed to a computer usable medium having a computer program embodied thereon. The computer program includes instructions for causing a computer to perform various operations of maintaining a list of people known to a user and using the list to control communications between the user and others. See, e.g., Application at page 1 line 7 to page 10 line 2, and FIG. 1. Specifically, the computer program embodied on the computer usable medium includes instructions for maintaining a list of people known to a user. See, e.g., Application at page 6 line 7 to page 10 line 2, and FIG. 2. The computer program embodied on the computer usable medium also includes instructions for receiving a message directed from a sender to the user and enabling the user is to interact with the message from the sender. See, e.g., Application at page 13 line 26 to page 17 line 14; and FIG. 6-7. The computer program embodied on the computer usable medium also includes instructions for determining whether the send is known to the user based, at least in part, on interactions between the user and the received message directed to the user. The computer program embodied on the computer usable medium also includes instructions for adding the sender to the list when the person is determined to be known to the user based, at least in part, on interactions between the user and the received message; See, e.g., Application at page 14 line 22 to page 15 line 6; page 19 line 3 to page 20 line 13; and FIG. 8-9. The computer program embodied on the computer usable medium also includes instructions for using the list to control aspects of communications between the user and others based on whether the others are included on the list. See, e.g., Application at page 20 line

14 to page 24 line 11; FIG. 10-12; page 26 line 19 to page 27 line 9 and FIG. 16.

Independent claim 55 is directed to an apparatus that includes means for performing various functions of maintaining a list of people known to a user and using the list to control communications between the user and others. See, e.g., Application at page 1 line 7 to page 10 line 2 and FIG. 1. Specifically, the apparatus includes means to perform the function of maintaining a list of people known to a user. See, e.g., Application at page 6 line 7 to page 10 line 2, and FIG. 2. The apparatus also includes means to perform the function of receiving a message directed from a sender to the user and enabling the user to interact with the message from the sender. See, e.g., Application at page 13 line 26 to page 17 line 14; and FIG. 6-7. The apparatus also includes means to perform the function of determining whether the sender is associated with the user based, at least in part, on interactions between the user and the received message directed to the user. The apparatus also includes means to perform the function of adding the sender to the list when the person is determined to be with the user based, at least in part, on interactions between the user and the received message; See, e.g., Application at page 14 line 22 to page 15 line 6; page 19 line 3 to page 20 line 13; and FIG. 8-9. The apparatus also includes means to perform the function of using the list to control aspects of communications between the user and others based on whether the others are included on the list. See, e.g., Application at page 20 line 14 to page 24 line 11; FIG. 10-12; page 26 line 19 to page 27 line 9 and FIG. 16.

#### **(6) Grounds of Rejection to be Reviewed on Appeal**

The 35 U.S.C. § 103(a) rejections of claims 1-55 as being obvious over U.S. Patent No. 6,393,464 (Dieterman) in view of U.S. Patent No. 7,206,814 (Kirsch).

#### **(7) Argument**

##### Claim Rejections Under 35 U.S.C. § 103

Appellants request reversal of the rejection of claims 1-55 because none of Dieterman, Kirsch, or any proper combination of the two describes or suggests all of the features of independent claims 1, 28, and 55, as described more fully below. In addition, these references do not describe or suggest at least the features of dependent claims 3-6, 10-12, 30-33 and 37-39.

*Independent Claims 1, 28, and 55*

Appellants request reversal of the rejection of claims 1, 28 and 55 at least because , Dieterman and Kirsch, when taken individually or in combination, do not describe or suggest adding a sender to a list when the sender is determined to be associated with the user based, at least in part, on the interactions between the user and a received message that is directed from the sender to the user, as recited in independent claim 1, 28 and 55.

The Office Action acknowledges this deficiency of Dieterman and instead relies on Kirsch for this feature. See final Office Action of March 31, 2008 at page 3-4. However, Kirsch like Dieterman, is deficient and fails to describe or suggest this feature.

Kirsch uses a central database to collect statistics of senders and “determines the sender’s reputation ( a good reputation indicates that the sender does not send unwanted messages while a bad reputation indicates the sender sends unsolicited messages) [by analyzing information from various end users]” *Abstract*. The sender’s reputation information is then passed from the central database to e-mail recipients. As a result, the e-mail recipients can use the received global sender reputation information to filter received e-mails. *See Abstract*. Even assuming the good-reputation-sender list in Kirsch is equivalent to the list as claimed, a sender is added to the good-reputation-sender list based on global statistics about the sender.

However, the information analyzed to obtain the global statistics does not include interactions between the user and a received message directed from the sender to the user. Rather, the statistics are obtained by analyzing “[i]nformation [that] includes: information about the actual sender: whether the actual sender is included on the recipient’s white list; whether the actual sender is included on the recipient’s black list; whether the message could be categorized locally; and whether the recipient changed the whitelist/blacklist status of message (i.e., changed the whitelist/blacklist status of the message).” Col. 9:40-47 of Kirsch.

Therefore, similar to Dieterman, Kirsch also fails to describe or suggest adding a sender to a list when the sender is determined to be associated with the user based, at least in part, on the interactions between the user and a received message, as recited in independent claim 1. Similarly, independent claim 28 recites, “adding the sender to the list when the sender is determined to be associated with the user based, at least in part, on the interactions between the

user and the received message.” Claim 55 recites “means for adding the sender to the list when the sender is determined to be associated with the user based, at least in part, on interactions between the user and a received message directed to the user.” Applicant submits that Dieterman and Kirsch do not describe or suggest these features of claims 28 and 55 at least for the reason described with respect to claim 1.

*Dependant Claims 3-6, 10-12, 30-33 and 37-39*

Additionally, neither Dieterman nor Kirsch describe or suggest determining whether the sender is associated with the user based, at least in part, on interactions between the user and the received message that include “replying to, forwarding, saving or printing an e-mail received from the entity,” as recited in claim 3; “moving an e-mail from a first folder to a second folder,” as recited in claim 4; or “moving the e-mail from a first folder to a second folder,” as recited in claim 5; or “leaving an e-mail from the entity open for a predetermined period of time,” as recited in claim 6.

The Office Action relies on Dieterman for the specific actions recited in dependent claims 4-6, and 10-12. Office Action, pages 4-6. Initially, the rejection is deficient because it is logically inconsistent, which renders the Applicant unable to appreciate (or, more formally, to receive notice of) the actual rejection being applied. Specifically, in the first instance, the Office Action indicates that Dieterman does not describe or suggest determining that a sender is associated with the user based on interactions between the user and the received message, but then asserts that Dieterman does describe this feature with respect to the specific actions recited in dependent claims 4-6, and 10-12. If Dieterman does not describe or suggest determining that a sender is associated with the user based on general interactions between the user and the received message, then Dieterman can not describe or suggest doing so based on the specifically recited interactions. Therefore, the rejection leaves the Applicant unsure whether the Office is asserting that Dieterman discloses all features of the claims, or only a portion of them and, accordingly is improper.

In either event, neither Dieterman or Kirsch describe or suggest these features. Neither of these references describe or suggest adding a sender to a list when the sender is determined to be known to the user based on the interactions between the user and a received message, much less

doing so based on the specific interactions, such as moving e-mail from a first folder to a second folder (claims 4, 5), or leaving the e-mail open for a predetermined period of time (claim 6), as recited in dependent claims 4-6. With respect to claims 4 and 5, the Office Action points to an inbox folder and an outbox folder in Dieterman. *See, Office Action, page 4-5*. However, the mere existence of these two folders, or even the actions of moving e-mails between these folders does not describe or suggest a determination whether to add the sender to the list, as claimed. Further, with respect to claim 6, the Office Action cites col 5:44-46 of Dieterman which describes a message being deleted after a period of time if it not approved. The cited section does not show that the message is kept open, nor show that the sender is added to a list after the message is kept open for a period of time.

Further, neither Dieterman nor Kirsch describe or suggest determining whether the sender is associated with the user based on “detecting user actions that mitigate against factors that otherwise are used to infer a person is associated with the user,” as recited in claim 10, or specific mitigating actions such as “taking steps to report a communication from the person as spam,” as recited in claim 11; or “taking steps to add a person to a blacklist,” as recited in claim 12. With respect to claim 10, the Office Action cites col. 2:20-25 of Dieterman, which merely describes using an allowed list to control e-mail delivery. *See, Office Action, Page 6*. The cited section has nothing to do with mitigating factors as recited in claim 10. With respect to claim 11, the Office Action cites FIG. 6, Ref#88 of Dieterman “Delete Unapproved Incoming message”, which does not describe user taking steps to report a communication from the person as spam, as claimed. *See, Office Action, Page 6*. Further, with respect to claim 12, the Office Action cited an interface (FIG. 2 of Dieterman) for adding a person to the black list. *See, Office Action, Page 6*. However, the mere existence of a black list does not describe or suggest the feature of using the black list as a mitigating factor in determining whether to add the person to the list of people known to the user, as recited in claim 12.

Similarly, dependent claims 30-33, and 37-39 recite features similar to those recited in dependent claims 4-6, 10-12, and therefore are allowable for at least the reasons described above.

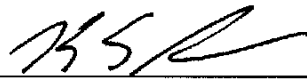
### Conclusion

Accordingly, Dieterman, and Kirsch, either alone or in combination, fail to describe or suggest all of the features of independent claims 1, 28, and 55. Similarly, these references fail to describe or suggest the features of dependent claims 3-6, 10-12, 30-33 and 37-39. Applicant submits that independent claims 1, 28, 55 and those claims that depend from them, are allowable over Dieterman and Kirsch for at least the reasons given above.

The brief fee in the amount of \$540 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 12/02/08

  
\_\_\_\_\_  
Kevin E. Greene  
Reg. No. 46,031

Fish & Richardson P.C.  
1425 K Street, N.W.  
11th Floor  
Washington, DC 20005-3500  
Telephone: (202) 783-5070  
Facsimile: (877) 769-7945

### Appendix of Claims

1. A method comprising:  
maintaining a list of people known to a user;  
receiving a message directed from a sender to the user;  
enabling the user to interact with the message from the sender;  
determining whether the sender is associated with the user based, at least in part, on interactions between the user and the received message directed to the user;  
adding the sender to the list when the person is determined to be known to the user based, at least in part, on interactions between the user and the received message; and  
using the list to control aspects of communications between the user and others based on whether the others are included on the list.
2. The method of claim 1 wherein the received message is an e-mail message received from the sender.
3. The method of claim 2 wherein the interactions include replying to, forwarding, saving, or printing the e-mail message received from the sender.
4. The method of claim 2 wherein the interactions include moving the e-mail from a first folder to a second folder.
5. The method of claim 4 wherein the first folder is an inbox folder and the second folder is a folder other than a delete folder or a spam folder.
6. The method of claim 2 wherein the interactions include maintaining the e-mail received from the sender in an open state for a predetermined period of time.
7. The method of claim 1 further comprising determining that a person is associated with the user based, at least in part, on the user sending a message to the person.



8. The method of claim 1 wherein the received message is an instant message.
9. The method of claim 1 further comprising determining that a person is associated with the user based, at least in part, on indicia other than actions performed by the user, wherein determining based on indicia other than actions performed by the user comprises:
  - accessing a contact list of the user to determine a first contact on the user's contact list;
  - and
  - accessing a contact list of the first contact to determine a second contact on the first contact's contact list.
10. The method of claim 1 further comprising determining that a person is associated with the user based, at least in part, on detecting user actions that mitigate against factors that otherwise are used to infer a person is associated with the user.
11. The method of claim 10 wherein the user actions comprise the user taking steps to report a communication from the person as spam.
12. The method of claim 10 wherein the user actions comprise the user taking steps to add a person to a blacklist.
13. The method of claim 10 wherein the user actions comprise the user taking steps to move a communication from the person to at least one of a spam folder or a delete folder.
14. The method of claim 1 wherein people associated with the user are people not distrusted by the user.
15. The method of claim 14 wherein using the list comprises using the list as a white list such that communications received from people on the list are exempt from spam filtering.
16. The method of claim 1 wherein using the list comprises using the list to restrict received communications to those communications from people on the list.

17. The method of claim 16 wherein the communications are e-mails.
18. The method of claim 16 wherein the communications are instant messages.
19. The method of claim 1 wherein people associated with the user are people known to the user.
20. The method of claim 19 wherein using the list comprises using the list to filter a display of e-mail such that e-mails from people on the list are shown on the display and e-mails from people not on the list are absent from the display.
21. (Original)The method of claim 19 wherein using the list comprises using the list to filter a display of e-mail such that e-mails from people not on the list are shown on the display and e-mails from people on the list are absent from the display.
22. (Original)) The method of claim 1 wherein using the list comprises using the list to restrict which instant messaging interfaces display an online presence of the user to those instant messaging interfaces associated with people on the list.
23. The method of claim 1 wherein using the list comprises using the list as a white list operating in conjunction with parental controls to filter communications from people not on the list when the communications include indicia that the content of the communication is inappropriate for a teen or child account user.
24. The method of claim 23 wherein filtering communications comprises blocking the communications from people not on the list when the communications include indicia that the content of the communication is inappropriate for a teen or child account user.
25. The method of claim 23 wherein filtering communications comprises placing communications from people not on the list in a spam folder when the communications

include indicia that the content of the communication is inappropriate for a teen or child account user.

26. The method of claim 25 wherein the spam folder is locked from the teen or child account user.

27. The method of claim 23 wherein the communications are e-mails.

28. A computer usable medium having a computer program embodied thereon, wherein the computer program comprises instructions for causing a computer to perform the following operations:

maintain a list of people known to a user;

receive a message directed from a sender to the user;

enable the user to interact with the message from the sender;

determine whether the sender is known to the user based, at least in part, on interactions between the user and the received message directed to the user;

add the sender to the list when the person is determined to be known to the user based, at least in part, on interactions between the user and the received message; and

use the list to control aspects of communications between the user and others based on whether the others are included on the list.

29. The medium of claim 28 wherein the received message is an e-mail message received from the sender.

30. The medium of claim 29 wherein the interactions include one or more of replying to, forwarding, saving, or printing the e-mail message received from the sender.

31. The medium of claim 29 wherein the interactions include moving the e-mail from a first folder to a second folder.

32. The medium of claim 31 wherein the first folder is an inbox folder and the second folder is a folder other than a delete folder or a spam folder.
33. The medium of claim 29 wherein the interactions include maintaining the e-mail received from the sender in an open state for a predetermined period of time.
34. The medium of claim 28 wherein the computer program further comprises instructions for causing a computer to infer that a person is associated with the user based, at least in part, on the user sending a message to the person.
35. The medium of claim 28 wherein the received message is an instant message.
36. The medium of claim 28 wherein the computer program further comprises instructions for causing a computer to infer that a person is associated with the user based, at least in part, on indicia other than actions performed by the user, wherein, to infer based on indicia other than actions performed by the user, the computer program further comprises instructions for causing a computer to:
  - access a contact list of the user to determine a first contact on the user's contact list; and
  - access a contact list of the first contact to determine a second contact on the first contact's contact list.
37. The medium of claim 28 wherein the computer program further comprises instructions for causing a computer to infer that a person is associated with the user based, at least in part, on detecting user actions that mitigate against factors that otherwise are used to infer a person is associated with the user.
38. The medium of claim 37 wherein the user actions comprise the user taking steps to report a communication from the person as spam.

39. The medium of claim 37 wherein the user actions comprise the user taking steps to add a person to a blacklist.
40. The medium of claim 37 wherein the user actions comprise the user taking steps to move a communication from the person to at least one of a spam folder or a delete folder.
41. The medium of claim 28 wherein people associated with the user are people not distrusted by the user.
42. The medium of claim 41 wherein, to use the list, the computer program further comprises instructions for causing a computer to use the list as a white list such that communications received from people on the list are exempt from spam filtering.
43. The medium of claim 28 wherein, to use the list, the computer program further comprises instructions for causing a computer to use the list to restrict received communications to those communications from people on the list.
44. The medium of claim 43 wherein the communications are e-mails.
45. The medium of claim 43 wherein the communications are instant messages.
46. The medium of claim 28 wherein people associated with the user are people known to the user.
47. (Original) The medium of claim 46 wherein, to use the list, the computer program further comprises instructions for causing a computer to use the list to filter a display of e-mail such that e-mails from people on the list are shown on the display and e-mails from people not on the list are absent from the display.
48. (Original) The medium of claim 46 wherein, to use the list, the computer program further comprises instructions for causing a computer to use the list to filter a display of e-mail such

that e-mails from people not on the list are shown on the display and e-mails from people on the list are absent from the display.

49. The medium of claim 28 wherein, to use the list, the computer program further comprises instructions for causing a computer to use the list to restrict which instant messaging interfaces display an online presence of the user to those instant messaging interfaces associated with people on the list.
50. The medium of claim 28 wherein, to use the list, the computer program further comprises instructions for causing a computer to use the list as a white list operating in conjunction with parental controls to filter communications from people not on the list when the communications include indicia that the content of the communication is inappropriate for a teen or child account user.
51. The medium of claim 50 wherein, to filter communications, the computer program further comprises instructions for causing a computer to block the communications from people not on the list when the communications include indicia that the content of the communication is inappropriate for a teen or child account user.
52. The medium of claim 50 wherein, to filter communications, the computer program further comprises instructions for causing a computer to place communications from people not on the list in a spam folder the communications include indicia that the content of the communication is inappropriate for a teen or child account user.
53. The medium of claim 52 wherein the spam folder is locked from the teen or child account user.
54. The medium of claim 50 wherein the communications are e-mails.

55. An apparatus comprising:

means for maintaining a list of people known to a user;

means for receiving a message directed from a sender to the user;

means for enabling the user to interact with the message from the sender;

means for determining whether the sender is associated with the user based, at least in part, on interactions between the user and the received message directed to the user;

means for adding the sender to the list when the person is determined to be known to the user based, at least in part, on the interactions between the user and the received message;  
and

means for using the list to control aspects of communications between the user and others based on whether the others are included on the list.

Applicant : Roy Ben-Yoseph  
Serial No. : 10/747,676  
Filed : December 30, 2003  
Page : 16 of 17

Attorney's Docket No.: 06975-0539001

### **Evidence Appendix**

None.



Applicant : Roy Ben-Yoseph  
Serial No. : 10/747,676  
Filed : December 30, 2003  
Page : 17 of 17

Attorney's Docket No.: 06975-0539001

### **Related Proceedings Appendix**

None